

Application No.: 09/918,261

Case No.: 56821US002

Remarks

Claims 1-21 are pending.

§ 103 Rejections

In order to present a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The Examiner has not met his burden for providing a *prima facie* case for obviousness. Even if the references can be combined as the Examiner suggests, no reference teaches a moisture curable, hot melt adhesive coating and/or sealant composition wherein all essentially amorphous hydroxy-functional materials in the composition have a $T_g \leq -20^\circ\text{C}$.

Claims 1-15 and 17-21 stand rejected under 35 USC § 103(a) as being unpatentable over Kangas (US 5,418,310) in view of Li et al. (US 6,221,978). Kangas teaches as a third component at least one essentially amorphous hydroxy-functional materials in the composition have a T_g greater than -20°C (See Kangas, Col. 5, lines 54-60.) Li teaches amorphous hydroxyl-functional materials with a T_g of -50°C . The combination of Kangas with Li would result in, at most, a composition comprising two separate amorphous materials, one with a T_g of between 0°C and 50°C and one with a T_g of -50°C . Therefore, even if one can combine Kangas with Li, it will not result in the present claims. The rejection of claims 1-15 and 17-21 under 35 USC § 103(a) as being unpatentable over Kangas in view of Li et al. has been overcome and should be withdrawn.

Claims 1-15 and 17-21 stand rejected under 35 USC § 103(a) as being unpatentable over Krebs et al. (US 2003/0045636) in view of Li et al. (US 6,221,978) and Kangas (US 5,418,310). Claims 1-21 stand rejected under 35 USC § 103(a) as being unpatentable over Oien (US 5,721,311) in view of Li et al. (US 6,221,978) and Kangas (US 5,418,310). Again, the Examiner relies on the

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combination of Li with Kangas to achieve the present claims. However, Kangas must be read as a whole, the Examiner may not pick and choose elements from a reference. Therefore, Kangas only teaches essentially amorphous hydroxy-functional material with a functionality of between 2 and 3.5 together with at least one essentially amorphous hydroxy-functional materials in the composition have a Tg greater than -20°C.

The rejection of claims 1-15 and 17-21 under 35 USC § 103(a) as being unpatentable over Krebs et al. in view of Li et al. and Kangas has been overcome and should be withdrawn. The rejection of claims 1-21 under 35 USC § 103(a) as being unpatentable over Oien in view of Li et al. and Kangas has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-21 at an early date is solicited.

October 14, 2003
Date

Respectfully submitted,

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